

Re. : Response to Office Action Mailed December 28, 2004
Appl. No. : 10/722,664
Filed : November 25, 2003

II. REMARKS

Claims 1-30 are currently pending in the application. The Office Action rejected Claims 1-3, 6-16, 18-26, 29 and 30. The Office Action also objected to Claims 4, 5, 17, 27 and 28 as being dependent upon a rejected base claim, but stated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By the foregoing amendments, Applicants amended Claims 1, 2, 3, 14, 15, 16, 24 and 25; and added new Claims 31-36 to clarify, define and/or broaden the claimed invention and to expedite receiving a notice of allowance. Pursuant to 37 C.F.R. § 1.121(f), no new matter is introduced by these amendments. Applicants believe that Claims 1-36 are now in condition for allowance.

Please note that Applicants' remarks are presented in the order in which the issues were raised in the Office Action for the convenience and reference of the Examiner. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner. Further, the following remarks are not intended to be an exhaustive enumeration of the distinctions between any particular reference and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and that reference.

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Response to the First Section 102(b) Rejection

The Office Action rejected Claims 1, 7-14, 19-23, 24, 29 and 30 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 6,004,231 issued to Schickert, et al. The Office Action asserts that the Schickert patent discloses a backboard (11) including a front surface, a rear surface, a first side and a second side; a first weight positioned proximate the first side of the backboard; a second weight positioned proximate the second side of the backboard; and a rim positioned proximate the front surface of the backboard; wherein the first weight (240) and the second weight (276) are sized and configured to enhance the rebounding characteristics of the backboard (Figs. 1, 22). The Office Action contends that, in as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claims 7 and 30, the Office Action contends that the Schickert patent discloses first and second weights constructed from generally rigid materials (5:42-50). As to claims 8 and 19, the Office Action contends that the Schickert patent discloses a reinforcement structure extending from the first side to the second side of the backboard (Figs. 5 and 22). As to claims 9, 12, 20 and 23, the Office Action contends that the Schickert patent discloses a reinforcement member disposed about the periphery of the backboard (Fig. 5). As to claims 10, 11, 19 and 22, the Office Action contends that the Schickert patent discloses a first and second weight forming a portion of a reinforcement structure and an elongated member extending from the first side to the second side (Fig. 22; items 240, 276). As to claim 13, the Office Action contends that the Schickert patent discloses removable weights (Figs. 22, 23). The Office Action also states that, in as much structure set forth by the applicant in the claims, the device is capable of use in the

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intended manner if so desired (See MPEP 2112). As to claims 14 and 24, the Office Action instructs to see the claim 1 rejection. As to claim 21, the Office Action contends that the Schickert patent discloses a first weight and second weight forming at least a portion of the reinforcing structure (fig 5).

Applicants respectfully traverse this rejection. However, in order to clarify, define and/or broaden the claimed invention, and expedite receiving a notice of allowance, Applicants amended Claims 1, 14 and 24.

For example, Applicants amended Claim 1 to provide “a first receiving portion in the first side of the backboard, the first receiving portion being sized and configured to receive at least a portion of the first weight” and “a second receiving portion in the second side of the backboard, the second receiving portion being sized and configured to receive at least a portion of the second weight, the first receiving portion being spaced apart from the second receiving portion.” Thus, Claim 1 now positively recites (1) a first receiving portion in the first side of the backboard is sized and configured to receive at least a portion of the first weight; (2) a second receiving portion in the second side of the backboard is sized and configured to receive at least a portion of the second weight; and (3) the first receiving portion is spaced apart from the second receiving portion.

In contrast, as shown in Figure 23 of the Schickert patent, the flanges 240 and 276 -- which the Office Action contends are “a first weight” and “a second weight,” respectively -- are secured directly against each other:

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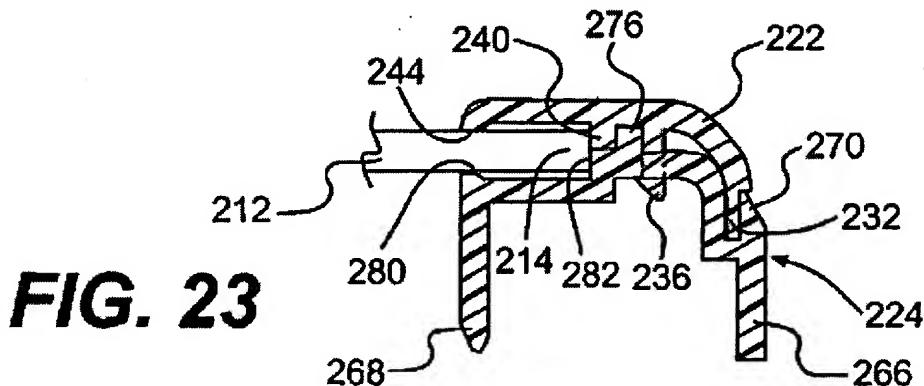


FIG. 23

Thus, as shown in Figure 23, the Schickert patent does not disclose, *inter alia*, a first receiving portion in the first side of the backboard, the first receiving portion being sized and configured to receive at least a portion of the first weight; and/or a second receiving portion in the second side of the backboard, the second receiving portion being sized and configured to receive at least a portion of the second weight, the first receiving portion being spaced apart from the second receiving portion. Thus, Schickert does not disclose each and every element of Claim 1.

Additionally, the Schickert patent does not disclose each and every element of Claim 14. For example, Claim 14 was amended to provide “a first attachment portion in the first side of the support frame;” “a second attachment portion in the second side of the support frame;” “a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame;” and “a second weight that is sized and configured to be attached to the second attachment portion in the second side of the support frame.” Thus, Claim 14 positively recites (1) a first attachment portion in the first side of the support frame; (2) a second attachment portion in the second side of the support frame; (3) a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame; and (4) a second weight that is sized and configured to be attached to the second

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attachment portion in the second side of the support frame.

The Schickert patent, however, does not disclose each and every element of Claim 14. For example, Figure 22 of the Schickert patent shows that the flanges 240 and 276 -- which the Office Action contends are “a first weight” and “a second weight,” respectively -- are integrally formed with the front frame 222 or the rear frame 224. Thus, the Schickert patent does not disclose, *inter alia*, a first attachment portion in the first side of the support frame; a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame; a second attachment portion in the second side of the support frame; and/or a second weight that is sized and configured to be attached to the second attachment portion in the second side of the support frame.

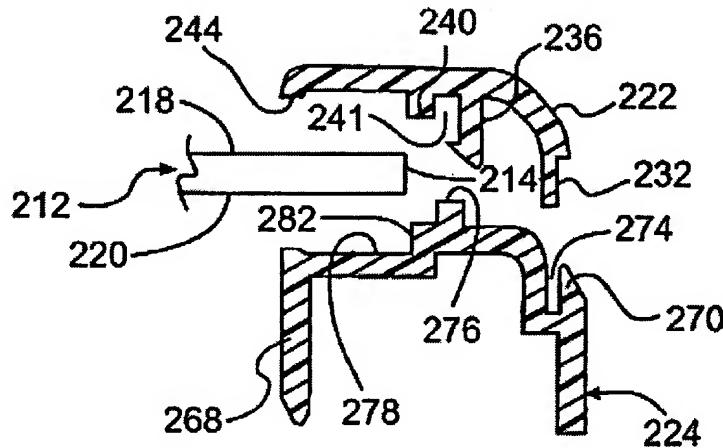


FIG. 22

Further, the Schickert patent does not disclose each and every element of Claim 24. For example, Claim 24 was amended to provide “a first weight that is separate and discrete from the backboard, the first weight being sized and configured to be attached to a first portion of the backboard” and “a second weight that is separate and discrete from the backboard, the second

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weight being sized and configured to be attached to a second portion of the backboard, the first portion of the backboard being spaced apart from the second portion of the backboard.” Thus, Claim 24 positively recites (1) a first weight that is separate and discrete from the backboard, the first weight sized and configured to be attached to a first portion of the backboard; (2) a second weight that is separate and discrete from the backboard, the second weight sized and configured to be attached to a second portion of the backboard; and (3) the first portion of the backboard spaced apart from the second portion of the backboard.”

The Schickert patent does not disclose each and every element of Claim 24. For example, the Schickert patent does not disclose, *inter alia*, a first weight that is separate and discrete from a backboard, the first weight being sized and configured to be attached to a first portion of the backboard; a second weight that is separate and discrete from the backboard, the second weight being sized and configured to be attached to a second portion of the backboard; and/or the first portion of the backboard being spaced apart from the second portion of the backboard.

Because Schickert does not disclose each and every element of independent Claims 1, 14 and 24, Applicants respectfully request that this Section 102(b) rejection of these claims be withdrawn. Applicants also request that the rejection of dependent Claims 7-13, 19-23, 29 and 30 be withdrawn at least because these claims are dependent upon independent Claim 1, 14 and/or 24, respectively.

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Response to the Second Section 102(b) Rejection

The Office Action rejected Claims 1-3, 7-12, 14-16, 19-23, 24-26, 29 and 30 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 4,424,968 issued to Smith. The Office Action asserts that the Smith patent discloses a backboard (10) including a front surface, a rear surface, a first side and a second side; a first weight positioned proximate the first side of the backboard; a second weight positioned proximate the second side of the backboard; and a rim positioned proximate the front surface of the backboard; wherein the first weight (13) and the second weight (12) are sized and configured to enhance the rebounding characteristics of the backboard (Figs. 1, 5). The Office Action contends that, in as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112). The Office Action asserts that the backboard is considered item 14.

As to claims 2, 15, and 25, the Office Action contends that the Smith patent discloses first and second weights partially disposed within the backboard (Fig. 3). As to claims 3, 16 and 26, the Office Action contends that the Smith patent discloses first and second openings partially disposed within the backboard (Fig. 3). Specifically, the Office Action contends that the weight at point 16 is considered partially disposed. As to claims 7 and 30, the Office Action contends that the Smith patent discloses first and second weights constructed from generally rigid materials (2:57-60). As to claims 8, and 19, the Office Action contends that the Smith patent discloses a reinforcement structure extending from the first side to the second side of the backboard (Fig. 5). As to claims 9, 12, 20 and 23, the Office Action contends that the Smith patent discloses a reinforcement member disposed about the periphery of the backboard (Figs. 1, 5). As to claims 10, 11, 19 and 22, the Office Action contends that the Smith patent discloses a

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first and second weight forming a portion of a reinforcement structure and an elongated member extending from the first side to the second side (Fig. 5). Specifically, the Office Action contends that the intersection of the reinforcing member 30 with the weights at points 31 and 32 meet this limitation. As to claims 14 and 24, the Office Action instructs to see the claim 1 rejection. As to claim 21, the Office Action contends that the Smith patent discloses a first weight and second weight forming at least a portion of the reinforcing structure (Fig. 5).

Applicants respectfully traverse this rejection. However, to clarify, define and/or broaden the claimed invention, and to expedite receiving a notice of allowance, Applicants amended Claims 1, 14 and 24.

For example, Applicants amended Claim 1 to provide “a backboard including a front portion forming at least a portion of a rebound surface, a generally opposing rear portion, and a perimeter including a first portion disposed on a first side of the backboard and a second portion disposed on an opposing second side of the backboard,” “a first receiving portion in the first side of the backboard, the first receiving portion being sized and configured to receive at least a portion of the first weight” and “a second receiving portion in the second side of the backboard, the second receiving portion being sized and configured to receive at least a portion of the second weight, the first receiving portion being spaced apart from the second receiving portion.” Thus, Claim 1 now positively recites (1) a backboard includes a front portion forming at least a portion of a rebound surface, a generally opposing rear portion, and a perimeter; (2) the perimeter includes a first portion disposed on a first side of the backboard and a second portion disposed on an opposing second side of the backboard; (3) a first receiving portion in the first side of the backboard is sized and configured to receive at least a

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portion of the first weight; (4) a second receiving portion in the second side of the backboard is sized and configured to receive at least a portion of the second weight; and (5) the first receiving portion is spaced apart from the second receiving portion.

As shown in Figure 3 of the Smith patent, the front panel 12 and the rear panel 13 -- which the Office Action contends are “a first weight” and “a second weight” -- abut front and rear sides of the polyurethane intermediate layer 14 -- which the Office Action contends are “a first side” and “a second side” of “a backboard”:

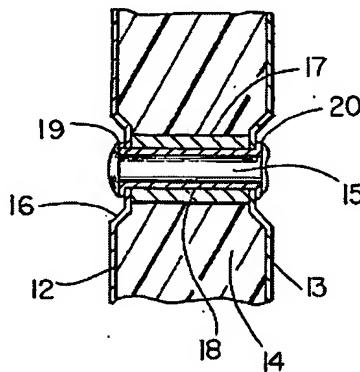


Fig. 3

In contrast, Claim 1 now clarifies the relationship among a front portion, a rear portion, an outer perimeter, a first side, and a second side of the backboard. And, as shown in Figure 3, Smith does not disclose each and every element of Claim 1.

Additionally, Smith does not disclose each and every element of Claim 14. For example, Claim 14 was amended to provide “a first attachment portion in the first side of the support frame;” “a second attachment portion in the second side of the support frame;” “a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame;” and “a second weight that is sized and configured to be attached to the second

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attachment portion in the second side of the support frame.” Thus, Claim 14 positively recites (1) a first attachment portion in the first side of the support frame; (2) a second attachment portion in the second side of the support frame; (3) a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame; and (4) a second weight that is sized and configured to be attached to the second attachment portion in the second side of the support frame.

The Smith patent, however, does not disclose, *inter alia*, a first attachment portion in the first side of the support frame; a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame; a second attachment portion in the second side of the support frame; and/or a second weight that is sized and configured to be attached to the second attachment portion in the second side of the support frame. Thus, the Smith patent does not anticipate Claim 14.

Further, the Smith patent does not disclose each and every element of Claim 24. For example, Claim 24 was amended to provide “a first weight that is separate and discrete from the backboard, the first weight being sized and configured to be attached to a first portion of the backboard” and “a second weight that is separate and discrete from the backboard, the second weight being sized and configured to be attached to a second portion of the backboard, the first portion of the backboard being spaced apart from the second portion of the backboard.” Thus, Claim 24 positively recites (1) a first weight that is separate and discrete from the backboard, the first weight sized and configured to be attached to a first portion of the backboard; (2) a second weight that is separate and discrete from the backboard, the second weight sized and configured to be attached to a second portion of the backboard; and (3) the first

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portion of the backboard spaced apart from the second portion of the backboard.”

The Smith patent does not disclose each and every element of Claim 24. For example, the Smith patent does not disclose, *inter alia*, a first weight that is separate and discrete from a backboard, the first weight being sized and configured to be attached to a first portion of the backboard; a second weight that is separate and discrete from the backboard, the second weight being sized and configured to be attached to a second portion of the backboard; and/or the first portion of the backboard being spaced apart from the second portion of the backboard.

Because the Smith patent does not disclose each and every element of Claims 1, 14 and 24, Applicants respectfully request that the Section 102(b) rejection be withdrawn. Applicants also request that the rejection of dependent Claims 2-3, 7-12, 15-16, 19-23, 25-26 and 29-30 be withdrawn at least because these claims are dependent upon independent Claims 1, 14 and 24 respectively.

Response to the Third Section 102(b) Rejection

The Office Action rejected Claims 1, 7-9, 12, 14, 20, 23, 24 and 30 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 4,285,518 by Pearo. The Office Action asserts that the Pearo patent discloses a backboard (10) including a front surface, a rear surface, a first side and a second side; a first weight positioned proximate the first side of the backboard; a second weight positioned proximate the second side of the backboard; and a rim positioned proximate the front surface of the backboard; wherein the first weight (50) and the second weight (32) are sized and configured to enhance the rebounding characteristics of the backboard (fig 1, 5). The Office Action contends that, in as much structure set forth by the

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applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claim 7 and 30, the Office Action contends that the Pearo patent discloses first and second weights constructed from generally rigid materials (Fig. 5, items 32, 50). As to claims 8, and 19, the Office Action contends that the Pearo patent discloses a reinforcement structure extending from the first side to the second side of the backboard (Fig. 5). As to claims 9, 12, 20 and 23, the Office Action contends that the Pearo patent discloses a reinforcement member disposed about the periphery of the backboard (Fig. 5, item 50). As to claims 14 and 24, the Office Action instructs to see the claim 1 rejection.

Applicants respectfully traverse this rejection. However, to clarify, define and/or broaden the claimed invention, and to expedite receiving a notice of allowance, Applicants amended Claims 1, 14 and 24.

For example, Applicants amended Claim 1 to provide “a first receiving portion in the first side of the backboard, the first receiving portion being sized and configured to receive at least a portion of the first weight” and “a second receiving portion in the second side of the backboard, the second receiving portion being sized and configured to receive at least a portion of the second weight, the first receiving portion being spaced apart from the second receiving portion.” Thus, Claim 1 now positively recites (1) a first receiving portion in the first side of the backboard is sized and configured to receive at least a portion of the first weight; (2) a second receiving portion in the second side of the backboard is sized and configured to receive at least a portion of the second weight; and (3) the first receiving portion is spaced apart from the second receiving portion.

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In contrast, as shown in Figure 5 of the Pearo patent, the backboard frame 50 and the bottom flange 32 -- which the Office Action contends are “a first weight” and “a second weight,” respectively -- are secured directly against each other:

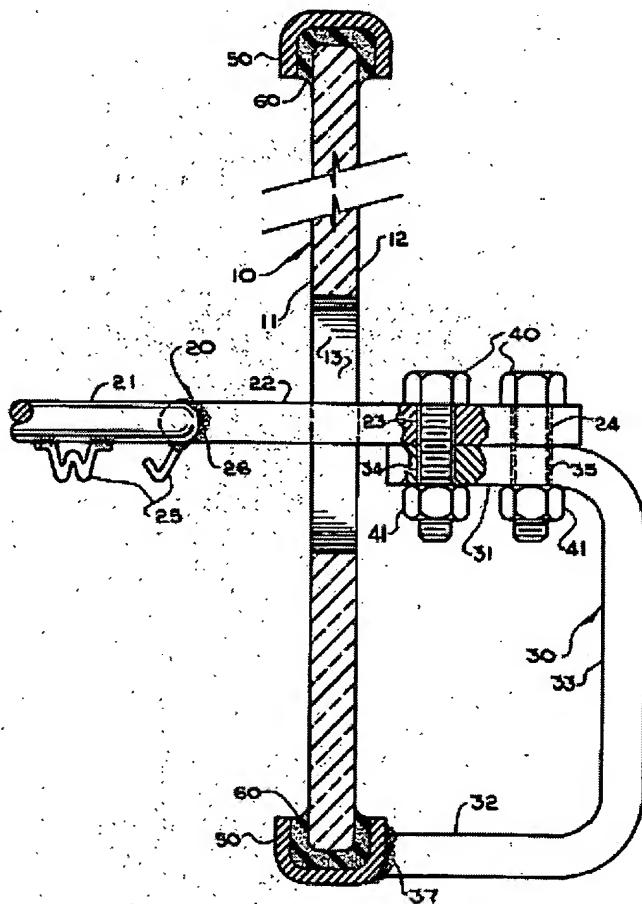


FIG. 5

See Pearo, 2:53-55. As shown in Figure 5, the Pearo patent does not disclose, *inter alia*, a first receiving portion in the first side of the backboard, the first receiving portion being sized and configured to receive at least a portion of the first weight; and/or a second receiving portion in the second side of the backboard, the second receiving portion being sized and configured to receive at least a portion of the second weight, the first receiving portion being spaced apart from

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the second receiving portion. Thus, the Pearo patent does not disclose each and every element of Claim 1.

Additionally, the Pearo patent does not disclose each and every element of Claim 14. For example, Claim 14 was amended to provide “a first attachment portion in the first side of the support frame;” “a second attachment portion in the second side of the support frame;” “a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame;” and “a second weight that is sized and configured to be attached to the second attachment portion in the second side of the support frame.” Thus, Claim 14 positively recites (1) a first attachment portion in the first side of the support frame; (2) a second attachment portion in the second side of the support frame; (3) a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame; and (4) a second weight that is sized and configured to be attached to the second attachment portion in the second side of the support frame.

However, the Pearo patent does not disclose, *inter alia*, a first attachment portion in the first side of the support frame; a first weight that is sized and configured to be attached to the first attachment portion in the first side of the support frame; a second attachment portion in the second side of the support frame; and/or a second weight that is sized and configured to be attached to the second attachment portion in the second side of the support frame.

Further, the Pearo patent does not disclose each and every element of Claim 24. For example, Claim 24 was amended to provide “a first weight that is separate and discrete from the backboard, the first weight being sized and configured to be attached to a first portion of the backboard” and “a second weight that is separate and discrete from the backboard, the second

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weight being sized and configured to be attached to a second portion of the backboard, the first portion of the backboard being spaced apart from the second portion of the backboard.” Thus, Claim 24 positively recites (1) a first weight that is separate and discrete from the backboard, the first weight sized and configured to be attached to a first portion of the backboard; (2) a second weight that is separate and discrete from the backboard, the second weight sized and configured to be attached to a second portion of the backboard; and (3) the first portion of the backboard spaced apart from the second portion of the backboard.”

The Pearo patent does not disclose each and every element of Claim 24. For example, the Pearo patent does not disclose, *inter alia*, a first weight that is separate and discrete from a backboard, the first weight being sized and configured to be attached to a first portion of the backboard; a second weight that is separate and discrete from the backboard, the second weight being sized and configured to be attached to a second portion of the backboard; and/or the first portion of the backboard being spaced apart from the second portion of the backboard.

Because the Pearo patent does not disclose each and every element of Claims 1, 14 and 24, Applicants respectfully request that the Section 102(b) rejection be withdrawn. Applicants also request that the rejection of dependent Claims 7-9, 12, 20, 23 and 30 be withdrawn at least because these claims are dependent upon independent Claims 1, 14 or 24 respectively.

Response to the Section 103(a) Rejection

The Office Action rejected Claims 6, 18 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Schickert patent in view of Claim 1. In particular, the Office Action contends that Claims 6, 18 and 29 are

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product-by-process claims, which are not considered patentable if the device of Schickert meets the limitations of the independent claim. The Office Action states that no criticality is seen in the type of process used to manufacture the device. The Office Action further adds that it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed anyone of several equivalent means of manufacture such as rotational molding or injection molding based on cost and design considerations.

Applicants respectfully traverse this rejection because, as shown above, the Schickert patent does not disclose each and every element of Claims 1, 14 and 24. Accordingly, Applicants request that these rejection of dependent Claims 6, 18 and 29 be withdrawn at least because these claims are dependent upon independent Claims 1, 14 and 24, respectively.

New Claims

Applicant added new Claims 31-36 to further clarify, define and/or broaden the claimed invention. Applicant respectfully submits that new Claims 31-36 are allowable over the cited references and are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants submit that Claims 1-36 are allowable over the cited references and are in condition for allowance. Accordingly, Applicants request that a Notice of Allowance be promptly issued.

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If any further impediments to allowance of this application remain, the Examiner is cordially invited to contact the undersigned by telephone so that these remaining issues may be promptly resolved.

The Commissioner is authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 23-3178.

Respectfully submitted,

Dated: June 27, 2005

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